

REMARKS

Reconsideration and allowance of the present application are respectfully requested.

Statement Under 37 C.F.R. §1.133(b)

In response to the telephonic interview conducted Thursday, March 12, 2009, Applicant wishes to thank the Examiner for the courtesies extended during the interview. Applicants submit the following discussion to provide a complete record of the issues discussed during the Examiner Interview.

Applicants and Examiner discussed the feature, "receiving, at a first network controller operating according to a first radio technology, a message relay request from a mobile station," of claim 1. Applicants argued that U.S. Patent Pub. No. 7,359,347 to Ahmavaara et al. ("Ahmavaara") does not disclose this feature because the network controller in Ahmavaara does not receive requests from a mobile station. More specifically, Ahmavaara discloses receiving, at a first network controller (7), a multitude of "connection quality measurement reports" from a mobile station (MS1). (Ahmavaara at col. 8, lns. 1-6) Connection quality measurement reports are not requests from the mobile station. The reports are only a list of measurements. This is underscored by the fact that the first network controller (7) independently determines whether a triggering event has taken place based on the connection quality measurement reports. (Id. at col. 4, lns. 44-54; col. 7, lns. 60-65.) The Examiner agreed that the abovementioned feature was not disclosed by Ahmavaara.

Applicants also note that during the interview, the Examiner noted the maturity of the field of art of the present application. The Examiner stated that while the above argument would overcome the § 102 rejection based on Ahmavaara, it does not

necessarily foreclose the possibility of a § 103 rejection based on the same. In view of the Examiner's comments, independent claim 1 is amended to place it in allowable form and to overcome Ahmavaara *en toto*. No other pertinent matters were discussed.

Rejections under 35 U.S.C. §112, First Paragraph

Claims 11-18 stand rejected under 35 U.S.C. §112, first paragraph, as a single means claim. Applicants respectfully traverse this rejection.

The MPEP requires Examiners to reject single means claims under 35 U.S.C. § 112, first paragraph for undue breadth of claim scope. (MPEP § 2164.08(a) (citing In re Hyatt, 708 F.2d 712, 714-715 (Fed. Cir. 1983).) However, this rule is circumscribed to situations where a claim covers every conceivable structure for achieving a recited process while, at the same time, the specification discloses at most only those known to the inventor. (Id.) In the case at hand, the single process recited in claim 11 is limited to a specific structure, "a second network controller," and therefore does not cover every conceivable structure for achieving the "receiving a relay message" step. As such, claim 11 falls within the exception of In re Hyatt. Therefore, withdrawal of this rejection is requested.

Rejections under 35 U.S.C. §102 - Ahmavaara

Claims 1-18 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Pub. No. 7,359,347 to Ahmavaara et al. ("Ahmavaara"). Applicants respectfully traverse this rejection.

In light of the agreements reached by the parties during the Examiner Interview, this art grounds of rejection of claim 1 is rendered moot.

Additionally, Applicants further note that amended claim 1 requires *inter alia*, “sending the relay message over a tunneling medium to a second controller operating according to a second radio technology.” This feature is also not disclosed or suggested by Ahmavaara.

Ahmavaara discloses a method of establishing simultaneous circuit switched and packet switched connections. (Ahmavaara col. 3, lns. 26-47; FIG. 1.) In the method, when a triggering event is detected by a first network controller (7), the first network controller (7) sends a “relocation request message” to a mobile switching center (MSC 13) operating according to a GSM network. (Id. at col. 4, lns. 44-54; col. 7, lns. 60-65.) The mobile switching center (13) then sends this message to a second network controller (11) also operating according to a GSM network. No tunneling medium, or other type of direct connection, takes place between the first network controller (7) and the second network controller (11).

Ahmavaara does not disclose the “sending” step recited above for at least two reasons. First, in Ahmavaara, the “relocation request message” is not sent to the second network controller (11), but instead to a mobile switching center (MSC 13). In contrast, claim 1 requires, *inter alia*, “sending the relay message [...] to a second controller.” Second, in Ahmavaara, the “relocation request message” is sent over a standard connection. In contrast, claim 1 requires, *inter alia*, “sending the relay message over a tunneling medium.” Thus, Ahmavaara does not disclose sending a “relocation message” to a second network controller (11) operating according to a second radio technology. Accordingly, Ahmavaara does not disclose or suggest the abovementioned feature of claim 1.

Applicants further submit that dependent claims 2-10 are allowable at least by virtue of their dependency from claim 1. Claim 11 is a separate independent claim

and should be interpreted solely based on the features therein. However, independent claim 11 and its dependent claims 12-18 are allowable at least for reasons somewhat similar to those set forth above with regard to claim 1. Therefore, Applicants respectfully requests that this art grounds of rejection of these claims under 35 U.S.C. § 102 be withdrawn.

Rejections under 35 U.S.C. §102 - Guilford

Claims 19-40 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Pub. No. 2002/0087674 to Guilford et al. ("Guilford"). Applicants respectfully traverse this rejection.

Claim 19 requires, *inter alia*, "sending at least one message identifying (i) wireless elements in use by a wireless unit and (ii) wireless elements available to the wireless unit for each of a plurality of network types." At least this feature is not disclosed or suggested by Guilford.

Guilford discloses a system for intelligent network selection for a wireless device (12). (Guilford para. [0067].) When a wireless device (12) powers-up, the device itself decides to connect with one service provider from a predetermined roaming table (e.g., a high speed data related connection, a narrow band connection, etc.). (Id.) The wireless device (12) does not send any messages including available base stations to any wireless element of the service provider.

The Examiner argues that Guilford discloses the "sending" step recited in claim 1. The Examiner asserts that the "sending" step in claim 19 reads on selecting a service provider, as disclosed in Guilford. However, Guilford does not disclose claim 19 for at least two reasons. First, in Guilford, a service provider is determined when the wireless device (12) powers up. That is to say, there are no wireless elements in

use when the process in Guilford is realized. In contrast, claim 19 requires, "sending at least one message identifying (i) wireless elements in use by the wireless unit." Second, in Guilford the wireless device (12) independently makes a determination of which service provider to connect to based on a roaming table. In other words, wireless device (12) does not send any messages identifying units of a service provider to connect to. In contrast, claim 19 requires, "sending at least one message identifying (i) wireless elements in use by the wireless unit and (ii) wireless elements available to the wireless unit for each of a plurality of network types." Therefore, Guilford does not disclose or suggest the abovementioned claim 19 feature.

Applicants further submit that dependent claims 20-28 are allowable at least by virtue of their dependency from claim 1. Claim 29 is a separate independent claim and should be interpreted solely based on the features therein. However, independent claim 29 and its dependent claims 30-40 are allowable at least for reasons somewhat similar to those set forth above with regard to claim 19. Therefore, Applicants respectfully requests that this art grounds of rejection of these claims under 35 U.S.C. § 102 be withdrawn.

Rejections under 35 U.S.C. §103 – Kim in view of Platt

Claims 2, 4, 6, 10, 12-13 and 15-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kim et al. ("Kim"), in view of Platt et al. (hereinafter "Platt"). The Examiner did not provide the publication number of either reference in the body of the Office Action, nor in the attached PTO-892 form. Furthermore, the Examiner does not provide any arguments in support of the rejection. It seems that this was an oversight by the Examiner.

CONCLUSION

Accordingly, in view of the above, reconsideration of the objections and rejections and allowance of each of claims 1-40 in connection with the present application is earnestly solicited.

As discussed above, Applicants respectfully request that the Examiner contact the undersigned to discuss the Applicants' reasoning and/or possible claim amendments that may place the application in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura, at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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